

REMARKS

Claims 44-63 are currently pending. Claims 64 and 65 are added, with support found at least at page 3, lines 4-8, and page 6, lines 7-10. Claims 60 and 61 are amended for preamble consistency. No new matter has been added.

IDS

Thank you for your consideration of the references submitted on the IDS of May 10, 2004. We noted the extensive number of references crossed out because they were not provided. However, upon checking USPTO PAIR, the references are available in the image file wrapper as being provided on May 10, 2004. A Supplemental IDS listing the “crossed-out” references is provided with this Response for your convenience.

35 U.S.C. § 112 Written Description

Claims 44-63 are rejected under 35 USC § 112, first paragraph, asserting that “[T]here is no disclosure and support for expectation of only 1 peroxy acid or other peroxy compound having any reduction in antimicrobial effects, particularly when applied to any plant tissue of any plant species.” Applicants disagree and traverse this rejection.

The written description requirement is satisfied when Applicants’ specification conveys with reasonable clarity to those skilled in the art, that as of the filing date sought, he or she was in possession of the invention. Vas-Cath Inc. v. Mahurkar, 19 USPQ2d 1111, 1116 (Fed. Cir. 1991).

Support for the presented claims can be found throughout the specification as filed, including at least at the Summary of the Invention, at page 7, lines 3-9, at page 9, lines 3-10, at page 16, lines 6-9, and the claims as originally filed. Support for use of both a single peroxyacid/acid composition as well as mixed peracid compositions is provided. For example, the Summary provides in part:

We have found that a mixed peracid/acid treatment composition can be used to protect growing plant tissue from the undesirable effects of microbial attack. The peracid/acid composition used in this invention can be applied to growing plant tissues and can provide residual antimicrobial effects after the plant has completed its growth cycle, fruit or vegetable material have been harvested and sent to market. The composition of the invention has been found to have excellent

antimicrobial effects but poses little toxic effects to agricultural workers or the ultimate consumer.

We have found that peroxy acid/acid compositions can be an effective treatment of living or growing plant tissues including seeds, roots, tubers, seedlings, cuttings, rooting stock, growing plants, produce, fruits and vegetables, etc. Under certain circumstances, a single peroxyacid/acid composition can be effective; however, in other circumstances, a mixed peroxy acid/acid composition has substantially improved and surprising properties. (emphasis added).

In addition, there has been no evidence provided by the Office as is required to challenge the veracity of the specification. The law requires that the specification be taken as true unless there is evidence otherwise. See *In re Marzocchi*, 439 F.2d 220, 223, 169 USPQ 367, 369 (CCPA 1971), standard adopted by Federal Circuit in *In re Brana*, 51 F.3d 1560, 34 USPQ2d 1436 (Fed. Cir. 1995).

The specification disclosure corresponds in scope to the claims and no evidence has been presented to challenge those teachings. Applicants assert the claims meet the written description requirements and request withdrawal of the rejection.

35 U.S.C. § 112 Enablement

Claims 44-60, 62 and 63 are rejected as allegedly non-enabled. Applicants respectfully traverse and disagree with the Office's characterization of the claims.

Under the law of enablement, a specification which teaches how to make and use the invention in terms which correspond in scope to the claims must be taken as satisfying the enablement requirement unless there is reason to doubt the objective truth of the specification. *In re Marzocchi*, 169 USPQ 367, 369 (CCPA 1971). It is incumbent upon the Examiner to explain why one skilled in the art would doubt the truth of statements made in the specification, and provide back up assertions with acceptable evidence or reasoning which is inconsistent with the teachings of the specification. *Id.* at 370. Absent evidence to the contrary, the specification must be assumed to be enabling.

The rejection for lack of enablement fails to explain why one skilled in the art would be unable to make and use the claimed method as described or why one would doubt the truth of statements made in the specification. Instead the rejection relies on the following unsupported conclusions. The unpredictability in the art is alleged to be "high" –despite the Office also

asserting that the use of the compounds for specific antimicrobial functions have been previously shown. The rejection also asserts that the claims are to “unqualified control and death by agents” and that the undue experimentation is required because “there is no known levels of amount useful for any specific agent against any specific organism shown to exhibit death and destruction of any microbe on any particular living plant tissue.” Applicants disagree.

Contrary to the assertion of the Office, enabling description is provided to make and use both concentrated and use solutions of peracid/acid combinations with further guidance for application on living plants and seeds for antimicrobial control. The effectiveness of various compositions against example organisms is provided in Examples 1 and 2. Consequently, the provided description is sufficient for one to make the composition and apply it to a living plant for controlling microbial pathogens on living plant tissue. Hence, the standard for enablement has been met. Withdrawal of the rejection is requested.

35 U.S.C. § 102 Anticipation

Claims 44-60, 62 and 63 are rejected as allegedly anticipated by, or in the alternative, obvious over HAMON GODIN et al. (6,166,808). Applicants respectfully traverse.

The claimed methods are directed to the use of a peracid and an additional carboxylic acid other than the peracid used to enhance effectiveness in controlling microbial pathogens on living plant tissue. The prior art does not disclose or suggest this combination.

Hamon fails to teach all the limitations of the claims as is required for both anticipation and obviousness. Hamon’s composition of peracetic acid and amine oxides is applied to surfaces of premises, equipment, tools, utensils, and containers. These inanimate surfaces may be made of materials such as wood, glass, metal, or organic polymers. Col. 7, lines 29-37. Hamon does **not** disclose or suggest treating any living tissue, including living plant tissue.

The Office asserts since Hamon suggests “wood” that application to living plant tissues are also suggested. Applicants disagree. In Hamon, “wood” refers only to an inanimate material, not to a living stand of living trees.

Furthermore, Hamon lacks any teaching or suggestion that their disclosed composition is function on or suitable for contact with living plant tissue.

For at least the reasons that Hamon fails to teach all the limitations of the claims and lacks teaching or suggestion to apply peracid compositions to living plant tissue, the claims are

not anticipation and the claims are not obvious in view of Hamon. Withdrawal of the rejection is respectfully requested.

35 U.S.C. § 103 Obviousness

Claims 44-63 are rejected as allegedly unpatentable over HAMON GODIN (6,166,808) and EGGENSPERGER et al. (4,129,517) or HILGREN (6,627,657). Applicants respectfully traverse.

To establish a prima facie case of obviousness, the Office must show that: 1) the references when combined must teach or suggest all of the claim limitations; 2) a suggestion to modify the references or combine the reference teachings must be present; and 3) the references when combined must provide a reasonable expectation of success. Applicants submit that all of these requirements have not been met.

As indicated above, Hamon fails to disclose treating living plant tissue for control of microbial pathogens. Eggenesperger and Hilgren, taken in combination with Hamon, do not remedy the lack of teaching by Hamon.

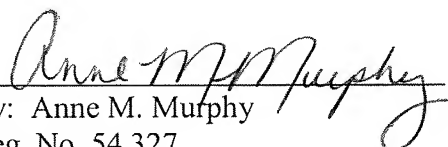
For at least the above reasons, the combination of Hamon, Eggenesperger and Hilgren fails to present a prima facie case of obviousness of the claims. Withdrawal of the rejection is respectfully requested.

Summary

In view of the above amendments and remarks, Applicant respectfully requests a Notice of Allowance. If the Examiner believes a telephone conference would advance the prosecution of this application, the Examiner is invited to telephone the undersigned at the below-listed telephone number.

Respectfully submitted,
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